

by one or a number of halogen atoms or groups such as -OH, -O-alkyl, -S-alkyl, cyano or alkyl;

*D-2
Contd*
R₁₁ and R₁₂ represent, independent of one another, a hydrogen or halogen atom;

R₁₃ represents a halogen atom or a haloalkyl, haloalkoxy, -S (O)_qCF₃ or -SF₅ group;

m, n, q and r represent, independently of one another, an integer equal to 0, 1 or 2;

X represents a trivalent nitrogen atom or a C-R₁₂ radical, the other three valencies of the carbon atom forming part of the aromatic ring;

with the proviso that, when R₁ is methyl, then R₃ is haloalkyl, R₄ is NH₂, R₁₁ is Cl, R₁₃ is CF₃ and X is N.

REMARKS

This amendment is in response to the Office Action dated February 22, 2001.

Claims 1 and 17-39 are pending. Claims 1 and 17-39 are rejected under 35 U.S.C. § 103(a) for allegedly being obvious in view of a combination of five prior art references. In order to place the claims in condition for allowance, Applicant has amended claims 1 and 17, which more particularly point out and distinctly claim what Applicant regards as his invention. Support for the amendments can be found, for example, at page 2, lines 27-28 of the instant specification and in the originally filed claims. As such, no new matter has been added by these amendments.

This submission is accompanied by a Petition Under 37 C.F.R. § 1.137(b) to revive the instant application which was unintentionally abandoned. Following grant of

the Petition and entry of the instant amendment, claims 1 and 17-39 will remain pending.

In accordance with 37 C.F.R. §1.121, Applicant has provided (1) accurate instructions to amend the claims, (2) replacement claims in clean form herein, and (3) another version of the amended claims, attached hereto as Exhibit A, marked up to show all the changes relative to the previous version of the claims. A clean version of the claims that will be pending upon grant of the Petition Under . § 1.137(b) and upon entry of this Amendment is attached hereto as Exhibit B.

For reasons set forth in detail below, Applicant requests that the sole, outstanding rejection be withdrawn and all pending claims be allowed.

The Rejections Under 35 U.S.C. § 103(a) Should Be Withdrawn

Claims 1 and 17-39 have been rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious by Derwent Publication Abstract No. 77-872784 to Hiraiwa Daiku ("Hiraiwa") in view of four secondary references: (1) Derwent Publication Abstract No. 81-06781D to Yoshitomi Pharm. ("Yoshitomi"); (2) Chemical Abstract No. 1993:497510 to Yamauchi ("Yamauchi"); (3) WO95/22902 to Kodama et al. ("Kodama"); and (4) Chemical Abstract No. 1987:454179 to Metzner et al. ("Metzner"). The Examiner alleges that (1) Hiraiwa teaches a wood adhesive composition consisting essentially of a suitable amount of insecticide and an adhesive; (2) Kodama teaches pyrazole compounds, including fipronil, which are useful as insecticides; (3) Yoshitomi teaches phenol-formaldehyde resin and resorcinol-formaldehyde resin which are useful as wood adhesives; (4) Yamauchi teaches ethylene-vinyl acetate copolymer which is useful as a

wood adhesive; and (5) Metzner teaches compositions consisting of an adhesive and a biocide, particularly against termites, which are useful for wood products (July 27, 2000 Office Action at pages 2-3). Further, the Examiner alleges that it would have been *prima facie* obvious to a person of ordinary skill in the art to modify the composition of Hiraiwa in light of the four secondary references to achieve the claimed compositions.

Applicant respectfully disagrees. First, the Examiner recognizes that no single reference teaches the claimed subject matter, and no reference suggests combination with another reference to arrive at the claimed invention. In fact, as noted by the Examiner, the primary reference Hiraiwa neither teaches the use of the pyrazole insecticide nor use of the claimed adhesives (*i.e.*, ethylene vinyl acetate copolymer, phenol-formaldehyde resin, or resorcinol-formaldehyde) (July 27, 2000 Office Action at Item No. 4). Ultimately, the Examiner hinges unpatentability of the pending claims on the theory that a person of ordinary skill in the art would have been motivated to combine the various prior art references to modify the composition of Hiraiwa, and thus arbitrarily select fiponil as the insecticide and either ethylene vinyl acetate copolymer, phenol-formaldehyde resin, or resorcinol-formaldehyde as the wood adhesive (July 27, 2000 Office Action at page 3).

Specifically, the Examiner states:

"[N]ote that it is known to incorporate an insecticide into wood adhesive to render a insecticidal property to the wood adhesive, it is, therefore, *prima facie* obvious to incorporate fipronil, a well-known insecticide against termite, into a wood adhesive. A person of ordinary skill in the art would have been reasonably expected to be successful in combining fipronil with a wood adhesive since the technique to combine an

insecticide and wood adhesive is known." (February 22, 2001 Office Action at page 2).

However, an assertion that modifications of the prior art to meet the claimed invention would have been obvious to one of ordinary skill in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the prior art references. See MPEP §2143.01. In particular, the level of skill in the art cannot be relied upon to provide the suggestion to combine the prior art references. See *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 1325, 50 U.S.P.Q.2d 1161, 1171 (Fed. Cir. 1999); see also MPEP §2143.01.

Without objective evidence, the Examiner offers that the skilled artisan, at the time of the invention, could have, with a reasonable expectation of success, combined fipronil with a wood adhesive since a technique of combining an insecticide and wood adhesive was known. However, this blanket statement ignores the critical importance of maintaining the insecticidal and adhesive properties when the two are combined. For example, since there are thousands of known pesticides, the skilled artisan simply cannot be said to have a reasonable expectation of success of producing compositions containing any known insecticide and an adhesive, and yet expect the final composition to maintain commercially effective adhesive and insecticidal properties. Similarly, many adhesives useful for woodworking are known, thereby increasing the unpredictability that any combination of a pyrazole insecticide and an adhesive would maintain commercially effective adhesive and insecticidal properties. Thus, the claimed composition cannot be said to be obvious given the inordinate number of possible combinations of adhesives and insecticides suggested by Hiraiwa.

functional
quality
material

Based on the foregoing, Applicant respectfully submits that there would have been neither motivation nor reasonable expectation of success in combining the cited references to arrive at the claimed compositions, and thus Hiraiwa does not render the claimed invention obvious, alone or in combination with any of the references cited by the Examiner. Accordingly, withdrawal of the rejection of Claims 1 and 17-39 under 35 U.S.C. § 103(a) is respectfully requested.

Conclusion

In view of the foregoing remarks, Applicant respectfully requests withdrawal of the outstanding rejection, and allowance of all the pending claims.

A courtesy copy of all the pending claims is attached hereto as Exhibit B.

No fee is believed due for filing of this paper, which is submitted together with a Continued Prosecution Application and a Petition to Revive Under 37 C.F.R. § 1.137(b). If any fee is due in connection with the filing of this paper, please charge the fee to our Deposit Account No. 02-4377. If any additional fee is required for an extension of time under 37 C.F.R. § 1.136, such an extension is requested and the fee should also be charged to our Deposit Account. A duplicate of this sheet is enclosed.

Respectfully submitted,
BAKER BOTTS L.L.P.

Dated: July 30, 2002

By: _____



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Patent Reg. No. 32,439

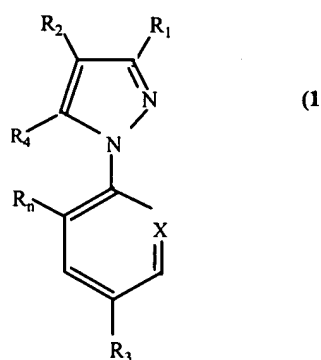
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EXHIBIT A

Marked-up version of amended claims

1. [A] An adhesive composition comprising a wood adhesive and an insecticidal active material of formula



(I):

in which:

R_1 is -CN or methyl;

R_2 is -S (O)_nR₃;

R_3 is alkyl or haloalkyl;

R_4 represents a hydrogen or halogen atom or an -NR₅R₆, -S (O)_mR₇, -C (O) R₇ or -C (O) O-R₇, alkyl, haloalkyl or -OR₈ radical or an -N=C (R₉) (R₁₀) radical;

R_5 and R_6 represent, independently of one another, the hydrogen atom or an alkyl, haloalkyl, -C(O) alkyl or -S (O)_rCF₃ radical or alternatively R_5

and R₆ can together form a divalent alkylene radical which can be interrupted by one or two divalent heteroatoms, such as oxygen or sulphur;

R₇ represents an alkyl or haloalkyl radical;

R₈ represents an alkyl or haloalkyl radical or a hydrogen atom;

R₉ represents an alkyl or haloalkyl radical or a hydrogen atom;

R₁₀ represents a phenyl or heteroaryl group optionally substituted by one or a number of halogen atoms or groups such as -HO, -O-alkyl, -S-alkyl, cyano or alkyl;

R₁₁ and R₁₂ represent, independently of one another, a hydrogen or halogen atom;

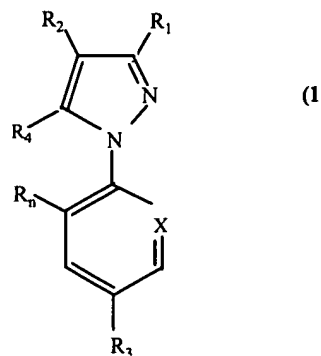
R₁₃ represents a halogen atom or a haloalkyl, haloalkoxy, -S(O)_qCF₃ or -SF₅ group;

m, n, q and r represent, independently of one another, an integer equal to 0, 1 or 2;

x represents a trivalent nitrogen atom or a C-R₁₂ radical, the other three valencies of the carbon atom forming part of the aromatic ring;

with the proviso that when R₁ is methyl, then R₃ is haloalkyl, R₄ is NH₂, R₁₁ is Cl, R₁₃ is CF₃ and X is N.

17. [A] An adhesive composition consisting essentially of a wood adhesive and an insecticidal active material of formula



(I):

in which:

R_1 is -CN or methyl;

R_2 is -S (O)_nR₃;

R_3 is alkyl or haloalkyl;

R_4 represents a hydrogen or halogen atom or an -NR₅R₆, -S (O)_mR₇, -C (O) R₇ or -C (O) O-R₇, alkyl, haloalkyl or -OR₈ radical or an -N=C(R₉) (R₁₀) radical;

R_5 and R_6 represent, independently of one another, the hydrogen atom or an alkyl, haloalkyl, -C(O) alkyl or -S (O)_rCF₃ radical or alternatively R_5 and R_6 can together form a divalent alkylene radical which can be interrupted by one or two divalent heteroatoms, such as oxygen or sulphur;

R_7 represents an alkyl or haloalkyl radical;

R₈ represents an alkyl or haloalkyl radical or a hydrogen atom;

R₉ represents an alkyl or haloalkyl radical or a hydrogen atom;

R₁₀ represents a phenyl or heteroaryl group optionally substituted by one or a number of halogen atoms or groups such as -OH, -O-alkyl, -S-alkyl, cyano or alkyl;

R₁₁ and R₁₂ represent, independent of one another, a hydrogen or halogen atom;

R₁₃ represents a halogen atom or a haloalkyl, haloalkoxy, -S (O)_qCF₃ or -SF₅ group;

m, n, q and r represent, independently of one another, an integer equal to 0, 1 or 2;

X represents a trivalent nitrogen atom or a C-R₁₂ radical, the other three valencies of the carbon atom forming part of the aromatic ring;

with the proviso that, when R₁ is methyl, then R₃ is haloalkyl, R₄ is NH₂, R₁₁ is Cl, R₁₃ is CF₃ and X is N.